

REMARKS/ARGUMENTS

These remarks are submitted responsive to the final office action dated August 13, 2004 (Office Action). As this response is timely filed within the three-month statutory period, neither an extension of time nor a fee is required.

In paragraph 1 of the Office Action, the Examiner indicates that claims 1-52 are presently pending in the current application. Applicants previously withdrew claims 27-31 and 53-58 from the instant application because of a restriction requirement set forth in a telephone conference with the Examiner on February 26, 2004. Hence, claims 1-26 and 31-52 are presently pending in the current application, which is consistent with the remainder of the Office Action.

In paragraphs 2-22 of the Office Action, the Examiner has rejected claims 1-3, 6-9, 13, 16, 18, 20, 22-26, 32-34, 37-40, 44, 47, 49, and 51 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,230,168 to Unger (Unger). In paragraphs 23-30, the Examiner has rejected claims 5, 10-11, 36, and 41-42 under 35 U.S.C. § 103(a) as being unpatentable over Unger in view of U.S. Patent No. 6,486,892 to Unger in view of Stern (Stern). Additionally, in paragraphs 31-46, the Examiner has rejected claims 12, 14-15, 17, 21, 43, 45-46, 48, and 52 under 35 U.S.C. § 103(a) as being unpatentable over Unger in view of kee<p>oint (Keepoint).

In critiquing Unger, Applicants note that at the time the invention was made Unger was assigned to International Business Machines Corporation (IBM) of Armonk New York, as is the present invention. Under § 35 U.S.C 103(c), subject matter co-owned or subject of an assignment to the same person cannot be used as a reference for purposes of 103(a). Accordingly, the 35 U.S.C. § 103(a) rejections to claims 5, 10-12, 14-15, 17, 21, 36, 41-43, 45-46, 48, and 52 should be withdrawn, which action is respectfully requested.

Regarding, Keepoint, Applicants previously pointed out that the material contained no reference date to prove that it existed before November 17, 2000. The Examiner more narrowly focused the Keepoint reference to a single document dated October, 27, 2000, as opposed to a collection of documents having material having 2002 and 2003 dates, as clarified in a telephone conversation with the Examiner on October 13, 2004.

In response, Applicants have enclosed a Declaration under 37 C.F.R. § 1.131 supporting the removal of Keepoint as a reference. The Declaration is accompanied by a copy of the

Applicants' Confidential Invention Disclosure No. BOC8-1999-0079 (Disclosure) entitled "User Specified Parallel Data Fetching for Optimized Web Access." The Disclosure and Declaration demonstrate proof of conception for the claimed subject-matter of Applicants' invention at least as early as July 27, 1999, the submitted date of the Disclosure, which predates the effective date of Keepoint (October 27, 2000).

The Disclosure represents the completion of an internal International Business Machines Corporation (IBM) confidential disclosure form, which is a standardized document utilized by IBM and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure once the Disclosure has been completed. Any changes and/or additions are appended as an attachment to the IBM confidential disclosure form together with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since July 27, 1999.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present application, including each claim within the present application, has been prepared based upon the Disclosure. Further, as noted in the enclosed Declaration, prior to submission of the application to the USPTO, the inventors reviewed the application to insure that the claims and material contained therein are fully supported by the Disclosure.

Applicants further exercised due diligence from prior to the effective date of Keepoint until November 17, 2000, the filing date of the instant application. In regard to diligence, as set forth in the Declaration, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application. Instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the application sufficiently details the

inventive concepts detailed in the disclosure, at which time the application is expeditiously filed with the USPTO.

Since Applicants conceived of the present invention before the effective date of Keepoint and exercised due diligence in constructively reducing the invention to practice between the date of the Disclosure until the filing date, as supported by the enclosed Declaration, Keepoint should be withdrawn as a reference and the rejections to claims 12, 14-15, 17, 21, 43, 45-46, 48, and 52 should be withdrawn, which action is respectfully requested.

Further, in paragraphs 2-22 of the Office Action, the Examiner has objected to claims 1-3, 6-9, 13, 16, 18, 20, 22-26, 32-34, 37-40, 44, 47, 49, and 51 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,230,168 to Unger (Unger).

Prior to directly addressing the 35 U.S.C. § 102(e) rejections, Applicants shall briefly contrast their claimed invention with that of Unger. Applicants claim in claims 1 and 32 the steps of presenting hypermedia content containing hyperlinks to additional hypermedia content, storing selected ones of the hyperlinks, and caching hypermedia content associated with the stored hyperlinks during the presenting step. In effect, the Applicants describe a delayed viewing list. Since content of the delayed viewing list is cached while a user is viewing other Web content, the content of the delayed viewing list can be quickly presented to the user upon demand.

Unger, on the other hand, teaches a mechanism to bind hypermedia pages to one another to create a virtual book (referred to as a collection) of many hypermedia pages. The pages for the virtual book can be manually specified. Once a virtual book is compiled, it can be modified by authorized users. Unger is silent concerning a delayed viewing list.

Applicants respectfully disagree with the Examiner's assertion that Unger anticipates Applicants' independent claims 1, 22, or 32. For the convenience of the Examiner, Applicants herein duplicate the distinction between 35 U.S.C. § 102 and 103 as detailed in the MPEP. For Anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or implicitly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. § 103, the referenced teachings must be somehow be modified in order to meet the claims.

Applicants shall not discuss in this response whether a rejection under 35 U.S.C. § 103 based on Unger is appropriate on its merits, since such rejections cannot be asserted against the present invention under 35 U.S.C. § 103(c) because Unger and the present application represent art that was commonly assigned to IBM. Applicants instead point out distinguishing features between the present invention and Unger to show that at very least some modification of Unger is necessary to achieve the Applicants' claimed features, modifications which cause the 35 U.S.C. § 102 rejections to be inappropriate.

Turning now the claims 1 and 32, Applicants explicitly claim the step of:

presenting hypermedia content, said hypermedia content containing **hyperlinks** to additional hypermedia content;

storing selected ones of said hyperlinks in a delayed viewing list; and,

caching hypermedia content associated with said **stored hyperlinks during said presenting step.**

Applicants respectfully assert that Unger does not explicitly or implicitly teach any of the below six features, nor are these six features inherently present in Unger.

- (1) a delayed viewing list (from the storing step)
- (2) presenting hypermedia content containing hyperlinks (in a manner that hyperlinks can be selected for delayed viewing as per the storing step)
- (3) storing selected hyperlinks in a delayed viewing list (the selection being made from a the previously presented hyperlinks)
- (4) caching hypermedia content based on selections of presented hyperlinks
- (5) caching selected hypermedia content related to hyperlinks, DURING a step where the related hyperlinks are presented within hypermedia content
- (6) storing selected hyperlinks DURING a presenting step (since the caching step references the stored hyperlinks and occurs during the presenting step)

Regarding feature (1), the Examiner has cited in paragraph 51 that col. 16, lines 35-42, and col. 16 lines 54-67 teach a delayed viewing list. The referenced section, however talks about proxies or remote servers pre-fetching or pre-transmit data that is referenced by links included within the explicitly referenced material, whenever bandwidth and other responses are available

to improve response time. This pre-fetching retrieves material that has NOT been explicitly referenced.

Applicants believe the Examiner is equating a temporary memory store (implied) used by a proxy to pre-fetch data with the delayed viewing list. The delayed viewing list, however, is distinguishable from such a temporary memory store as by definition (page 11, lines 16-18) the delayed viewing list stores user selected hyperlinks. Unger fails to explicitly or implicitly teach a structure that stores user selected hyperlinks. Further, the referenced temporary memory would not inherently be used for such a purpose.

Regarding feature (2), the Examiner cited in paragraph 48 that col. 6, lines 65-67 and col. 7, lines 52-60 teach presenting hypermedia content containing hyperlinks (in a manner that hyperlinks can be selected for delayed viewing as per the storing step). Applicants respectfully disagree. The first citation teaches that a virtual book can be modified after initial creation by the addition of organizational aids. Applicants believe that the Examiner may be assuming that one way to modify such a book is to select a presented hyperlink. This, however, would represent a modification of Unger's teachings.

At column 4, lines 30-40 Unger teaches the manual specification of existing sets of files, database entries, or previously existing collections – for example, specifying lists of server sites, file directories, or URL text string patterns. At column 4, lines 42-45, Unger teaches automatic "scoping" by employing automatic hypertext link traversal to discover candidate material. At column 5, lines 1-4, Unger teaches defining a scope of a collection using a "table of contents" that somehow graphs hypertext interconnections within a collection. At column 5, lines 11-20, Unger teaches defining HTML files in a certain area of storage like a directory, disk, or site and binding these files to a collection. Unger itself fails to explicitly or implicitly teach that **hypermedia content** is to be **presented** that contains **hyperlinks** that a **user can select** for delayed viewing. Further, no such teaching is inherent to Unger.

Column 7, lines 52-60 teaches that an author can identify hypertext objects for compilation within boundary 40. Applicants believe that the Examiner may be assuming that this identification occurs via a Web browser, which is not explicitly or implicitly taught by

Unger. The addition of presentation via a Web browser represents at least a modification to the teachings of Unger.

Moreover, such a feature is not explicitly or implicitly taught by Unger, as FIG. 3 shows that boundary 40 is defined in such a manner that would not be possible for a user to define the shown boundary 40 by selecting hyperlinks contained presented hypertext content. More specifically, boundary 40 includes a root item 20, three items 22, 24, and 26 that are one hyperlink deep of item 20, one item 28 two hyperlinks deep of item 20, and excludes items 30 and 32 two hyperlinks deep of item 20. Because of the levels of embedding present in FIG. 3, a minimum of two, and more likely more, different Browser pages would have to be presented before the selections defined by boundary 40 could be made, which is not taught or suggested by Unger, which implies that boundary 40 could be defined in a single step.

Applicants emphasize that defining such a boundary as boundary 40 in a single step via **presented hypermedia content** (again not taught by Unger) is simply not possible with conventional technology, which again, which is not a flaw of Unger as Unger does not teach that boundary 40 is to be created by selected hyperlinks contained in presented hypertext media. Accordingly, Unger does not explicitly or implicitly teach feature (2), nor is it inherently present.

Regarding feature (3), the Examiner cited col. 1, lines 50 - 54 and col. 2, lines 10-13 as teaching storing selected hyperlinks in a delayed viewing list (the selection being made from a the previously presented hyperlinks). The cited reference, however, teaches that a collection that forms a virtual book can be created from one or more files. Applicants assume that the Examiner is intending the collection to be equivalent to the storing step. However, Unger fails to explicitly or implicitly teach that the creation of the collection occurs by selecting hyperlinks of a presented hypermedia document. Such a feature is not inherit in Unger. Further, noting the navigational properties of the created book from col. 1, lines 65 to col. 2 line 9, Applicants are not aware of how such a book could be created in accordance with feature (3). Regardless, any such creation would at least represent a modification of the teachings of Unger.

Regarding feature (4) the Examiner cited col. 2, lines 10-13, col. 4, lines 18-29, and column 7, lines 62-67 as well as col. 16, lines 54-67 as teaching caching hypermedia content based on selections of presented hyperlinks. The cited passages from column 2, 4, and 7 teach

that a collection can be created by selecting files. The cited passages from column 16, teaches that a proxy can automatically pre-fetch data to improve response time, which is not related to the creation of a collection. Applicants respectfully submit that these references and Unger in general fails to show that hypermedia content is cached based upon selections (make by a user) of hyperlinks (presented to the user). Accordingly, feature (4) is not expressly or implicitly taught by Unger, nor is it inherent.

Regarding feature (5), the Examiner cited col. 2, lines 10-13, col. 4, lines 18-29, and column 7, lines 62-67 as well as col. 16, lines 54-67 as teaching caching selected hypermedia content related to hyperlinks, DURING a step where the related hyperlinks are presented within hypermedia content. Column 16 does teach that hypermedia content can be pre-cached, which may imply that some hypermedia content is presented. Column 16, however, teaches that pre-caching is automatic based on available bandwidth. Unger fails to explicitly teach that content is selected and that the selected hypermedia content is cached. Further, the details of column 16 relate to different aspects (book utilization verses book creation) from details of columns 2, 4, and 7. At very least, the teachings of Unger would have to be modified to derive feature 5. Consequently, Unger does not explicitly or implicitly teach feature (5), nor is feature (5) inherent within Unger.

Regarding feature (6), the Examiner cited col. 1, lines 50-54 and col. 2, lines 10-13 as teaching the storing of selected hyperlinks DURING a presenting step (since the caching step references the stored hyperlinks and occurs during the presenting step). These lines of Unger teach a collection can be constructed from multiple files and that the linked files can be contained within a collection. Applicants respectfully believe that the Examiner is misinterpreting the creation of a collection (detailed at column 4 of Unger which is explained above for feature 2) to being equivalent to selecting hyperlinks within displayed hypermedia content, which is not explicitly or implicitly taught by Unger. More significantly, however, because of antecedent basis, Applicants have claimed that the storing of selected hyperlinks occurs DURING the presenting step (i.e. hypermedia content other than the displayed content is being stored responsive to a user selection of a displayed hyperlink). Unger fails to explicitly or implicitly provide this feature, nor is it inherent within Unger.

Referring to claim 22, for reasons similar to claims 1 and 32, the Applicants' claimed invention is not taught by Unger. Applicants have hereafter listed each limitation of claim 22 (underlined) and followed each limitation with the Examiner's cited reference from Unger and a reason why the cited reference fails to explicitly or implicitly teach the associated limitation.

LIMITATION: a content browser for presenting hypermedia content to a user;

Applicants note that Unger fails to teach such a browser and the Examiner has provided no reference from which this teaching is supposed to exist within Unger. Applicants further note, however, that in paragraph 49 in regard to a somewhat unrelated issue, the Examiner asserts that selecting Web pages in a browser is obvious. While Applicants do not agree with this assertion within the context given, Applicants note that such reasoning is improper under 35 U.S.C. § 102(e) as obviousness requires some modification of the teaching of Unger.

LIMITATION: a content cache for storing further hypermedia content related to said hypermedia content presented in said content browser; (Examiner references col. 2, lines 10-16, which teaches a collection of pages can be stored *to create a virtual book*.)

Applicants note that Unger fails to teach that user selected content related to PRESENTED hypermedia content is stored in any fashion, nor is a cache for this purpose taught by Unger.

LIMITATION: delayed viewing list for storing hyperlinks to said further hypermedia content in said content cache, said hyperlinks contained in said hypermedia content presented in said content browser, wherein said delayed viewing list is dynamically created responsive to user selections of hyperlinks that have been presented within the content browser; (Examiner references col. 1, lines 50-54, which teaches that a collection of pages can exist. The collection can include one or more files)

Applicants note that a collection is not dynamically created responsive to user selections of hyperlinks that have been presented within a content browser.

In paragraph 51, the Examiner cites col. 16, lines 35-42 and 54-57 as teaching a dynamically generated delayed viewing list. This reference provides no such teaching. The referenced section, however talks about proxies or remote servers prefetching or pretransmit data that is referenced by links included within the explicitly referenced material, whenever

bandwidth and other responses are available to improve response time. This prefetching retrieves material that has NOT been explicitly referenced. Unger explicitly teaches that a proxy automatically retrieves content (not based upon user selections of hyperlinks). Applicants respectfully assert that at very least, the cited portions of Unger would have to be modified to teach a **dynamically created delayed viewing list** based upon **user selections**.

LIMITATION: a delayed viewing list manager;

Applicants note that Unger fails to teach a delayed viewing list manager and that the Examiner has provided no reference from which this teaching is supposed to exist within Unger.

LIMITATION: said delayed viewing list manager downloading said further hypermedia content to said content cache during said presentation of said hypermedia content in said content browser (Col. 15, lines 47-57; Col. 16, lines 36-41, lines 54-67)

Applicants note that the prefetching of Unger retrieves material that has NOT been explicitly referenced, as opposed to material specifically selected by a user. So prefetch cache taught by Unger is NOT a delayed viewing list, which is a list of hyperpages selected by a user, but a pre-retrieval memory containing content anticipated by a remote server or proxy.

In summary, Applicants have respectfully pointed out six specific features with regard to claims 1 and 32 that are claimed by the Applicants and not explicitly or implicitly taught by Unger, nor are they inherent in Unger. Further, the Applicants have clarified several limitations of claim 22, which are not explicitly or implicitly taught by Unger. Even should the Examiner disagree with Applicants with respect to all six of the distinguished features, if only one of the six features is not explicitly or implicitly taught by (nor inherent within) Unger, a withdrawal of the 35 U.S.C. § 102(e) rejections with respect to claims 1 and 32 is merited. Further, if even one of the limitations of claim 22 are not explicitly or implicitly taught by (nor inherent within) Unger, a withdrawal of the 35 U.S.C. § 102(e) rejections with respect to claim 22 is merited.

Accordingly, Applicants believe that they have proven that Unger fails to anticipate independent claims 1, 22, and 32 in accordance with the 35 U.S.C. § 102 definitions required for an anticipation rejection. Consequently, the 35 U.S.C. § 102(e) rejections to claims 1, 22, and 32 and all dependent claims should be withdrawn, which action is respectfully requested. That is,

the Applicants respectfully request that the 35 U.S.C. § 102(e) rejections to claims 1-3, 6-9, 13, 16, 18, 20, 22-26, 32-34, 37-40, 44, 47, 49, and 51 be withdrawn in light of the above.

The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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Gregory A. Nelson, Registration No. 30,577

Richard A. Hinson, Registration No. 47,652

Brian K. Buchheit, Registration No. 52,667

AKERMAN SENTERFITT

Customer No. 40987

Post Office Box 3188

West Palm Beach, FL 33402-3188

Telephone: (561) 653-5000